

REMARKS

Applicant respectfully notes that the Examiner incorrectly cancelled claims 48, 51 and 54 in the Examiner's Amendment of the Notice of Allowance pursuant to M.P.E.P. §1214.06. The Examiner had issue a final rejection, rejecting claims 1-55. The Board of Patent Appeals and Interferences reversed the Examiner's rejections with respect to claims 1-46, 48, 51 and 54. While claims 48, 51 and 54 were dependent claims, the Examiner cannot cancel them simply because they depend upon a sustained rejected claim as these claims were previously not allowable. The Examiner should have rewritten these dependent claims in independent form pursuant to M.P.E.P. §1214.06 or, alternatively, set a 1-month time limit for Applicant to rewrite these dependent claims in independent form pursuant to M.P.E.P. §1214.06. On December 11 and 12, 2006, Applicant's attorney contacted SPE Weilun Lo who agreed with Applicant that these claims (claims 48, 51 and 54) should not be cancelled. SPE Lo informed Applicant to prepare a 37 C.F.R. §1.312 amendment to rewrite claims 48, 51 and 54 in independent form. As a result, Applicant prepared this 37 C.F.R. §1.312 amendment to rewrite claims 48, 51 and 54 in independent form. Accordingly, Applicant respectfully requests SPE Lo to submit a supplemental notice of allowance allowing claims 1-46, 48, 51 and 54.

Applicant notes that claims 48, 51 and 54 were not amended to overcome prior art but to rewrite claims 48, 51 and 54 in independent form. Hence, no prosecution history estoppel arises from the amendments to claims 48, 51 and 54. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 48, 51 and 54 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

As Applicant presently has not yet made payment of the Issue Fee and no new matter is added by this Amendment, it is respectfully submitted that the foregoing amendment is proper subject matter for this Section 312 Amendment.

The Commissioner is hereby authorized to charge any insufficiency of payment of the necessary fees associated with this communication, or credit any overpayment, to Deposit Account No. 50-0563 in the name of IBM.

Applicant respectfully requests that the Examiner call Applicant's attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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